Supreme Court of the United States

OCTOBER TERM, 1936.

No.....

BERNARD JOSEPH MUMM,
Petitioner (Plaintiff-Appellant below),

vs.

JACOB E. DECKER & SONS,
Respondent (Defendants-Appellees below).

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE EIGHTH CIRCUIT AND BRIEF IN SUPPORT THEREOF.

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PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE EIGHTH CIRCUIT.

Your petitioner, Bernard Joseph Mumm, respectfully prays for a writ of certiorari to the United States Circuit Court of Appeals for the Eighth Circuit to review the decision and final decree of that court entered on the 2nd day of November, 1936, "sustaining a Motion to Dismiss a Bill of Complaint in a suit for patent infringement."

The transcript of the record in the case, including the decision of said Circuit Court of Appeals, is furnished herewith in accordance with Rule 38 of this Court.

I.

SUMMARY AND SHORT STATEMENT OF THE MATTER INVOLVED.

This suit is one in equity for patent infringement and involves the sufficiency or insufficiency to state a valid cause of action of what has come to be known as the "short" Bill of Complaint in patent cases.

The "short" Bill used below sets forth issuance of the patents in suit, title in plaintiff, infringement by defendant, damage to plaintiff, and makes profert of the patents, but differs from the so-called "long" Bill in that it does not contain averments that the inventions of the patents in suit were not known or used by others in this country before the inventor's inventions or discoveries thereof, and were not patented or described in any printed publication in this or any foreign country before his discoveries or inventions thereof, or for more than two years prior to the filing of the application for said Letters Patent therefor, or that each invention was not in public use or on sale in this country prior to his inventions or discoveries or for more than two years prior to the filing of the respective applications, and does not contain averments that said inventions, and each of them, were not abandoned and that no applications for foreign patents for said inventions were filed more than twelve months prior to the filing of said applications in this country.

The District Court dismissed this "short" Bill by its final decree of November 4, 1935 (R. 2), on the ground of insufficiency of fact to constitute a valid cause of action in equity. The Circuit Court of Appeals, by its decision and final decree, filed November 2, 1936 (R. 10, 13), affirmed the action of the lower court. 81 F.(2) 77 Fade Sheets Dec. 21, 193

QUESTIONS PRESENTED.

A.

Are sufficient facts to constitute a valid cause of action in equity, so far as concerns paragraph 3 of Equity Rule 25, stated by a bill in equity for alleged infringement of United States Letters Patent which prays injunctive and other relief, and avers that the inventors were the first, original and joint inventors of the subject matter of the patent in suit and avers that application therefor was duly filed and all requirements of the then existing United States Statutes and rules of practice of the Patent Office were complied with and avers that the patent was duly granted whereof profert is made, but which bill fails to negative the existence of each of the conditions precedent to the patent grant as expressed in Sections 4886 and 4887 of the United States Revised Statutes, as amended, 35 U. S. C. A., Sections 31 and 32?

B.

Was paragraph 3 of Equity Rule 25, adopted by the United States Supreme Court November 4, 1912, and made effective February 1, 1913, intended to abolish and obviate the necessity of alleging compliance with Sections 4886 and 4887 of the United States Revised Statutes, 35 U. S. C. A., Sections 31 and 32, in a bill in equity for alleged infringement of United States Letters Patent?

II.

REASONS RELIED ON FOR THE ALLOWANCE OF THE WRIT.

The discretionary power of this Court is invoked upon the following ground:

1. The decision below of the Circuit Court of Appeals for the Eighth Circuit is in direct conflict with the decision on the same matter of the Circuit Court of Appeals for the Third Circuit in the case of *Moeller vs. Scranton Glass Co.*, 19 F. (2d) 14, wherein use of the so-called "short" Bill of Complaint was sustained.

2. The decision below of the Circuit Court of Appeals for the Eighth Circuit is in conflict with the following decisions of other United States Courts: *Zenith Carburetor vs. Stromberg Co.* (Michigan), 205 Fed. 158; *General Bakelite Co. vs. Nicholas* (New York), 207 Fed. 111; *Pittsburgh vs. Beler* (Penn.), 222 Fed. 950; *Just vs. Borden* (Penn.), 262 Fed. 163; *American Ball vs. Federal Cartridge Co.* (Minnesota), unreported but decided September 27, 1933, Equity No. 2720; *McCullough vs. Poultry Producers* (N. D. Cal.), 50 Fed. (2d) 945.

3. This important question of Federal Law affecting all equity patent infringement suits has not been, but should be, settled by the United States Supreme Court which promulgated the Federal Equity Rules.

III.

PRAYER.

WHEREFORE, your petitioner respectfully prays that a writ of certiorari be issued out of and under the seal of this Honorable Court directed to the United States Circuit Court of Appeals for the Eighth Circuit sitting in St. Louis, Missouri, commanding that court to certify to and to send to this Court for its review and determination, on a day certain to be therein named, a full and complete transcript of the record and all proceedings in the case numbered and entitled on its docket, No. 10,522, *Bernard Joseph Mumm, Ap-*

pellant, vs. Jacob E. Decker & Sons, Appellee, and that said decree of the United States Circuit Court of Appeals for the Eighth Circuit may be reversed by this Honorable Court, and that your petitioner may have such other and further relief in the premises as to this Honorable Court may seem meet and just; and your petitioner will ever pray.

Minneapolis, Minnesota, December 22nd, 1936.

Respectfully submitted,

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Washington, D. C.

RALPH MERCHANT,
727 Metropolitan Life Building,
Minneapolis, Minnesota,
Of Counsel.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

I.

OPINIONS BELOW.

The final decree of the District Court is found in the record (R. 2). The decision and final decree below of the Circuit Court of Appeals for the Eighth Circuit are found in the record (R. 10, 13) and are dated November 2, 1936, but unreported as yet.

II.

JURISDICTION.

The grounds of jurisdiction are:

A. The date of the decision of the Circuit Court of Appeals for the Eighth Circuit to be reviewed is November 2, 1936 (R. 10), and the date of the final decree to be reviewed is November 2, 1936 (R. 13). 81 F. (2) 77 (adv. sheets Dec. 3, 1936)

B. The decisions rendered in a suit in equity brought under the Federal Patent Statutes to determine the validity and infringement of Letters Patents Nos. 1,837,280 and 1,699,076.

C. The statute under which jurisdiction is invoked is United States Code Annotated, Title 28, Section 347; U. S. Judicial Code, Section 240 (2) as amended by the Act of February 13, 1925.

D. Cases believed to sustain the jurisdiction are:

Powers-Kennedy Contracting Corp. vs. Concrete Mixing & Conveyor Co., 282 U. S. 175, 177.

Saranac Automatic Machine Corp. vs. Wirebounds Patents Co., 282 U. S. 704, 705.

Smith vs. Magic City Kennel Club, 282 U. S. 784, 785.

III.

CONCISE STATEMENT OF THE CASE.

The facts are sufficiently stated in the petition.

IV.

SPECIFICATION OF ASSIGNED ERRORS INTENDED TO BE URGED.

The errors intended to be urged are:

A. The Circuit Court of Appeals for the Eighth Circuit erred in sustaining the decision of the District Court and holding the petitioner's Bill of Complaint insufficient to state a valid cause of action in equity.

B. The Circuit Court of Appeals for the Eighth Circuit erred in not reversing the decision of the District Court and in not holding that the petitioner's Bill of Complaint was sufficient to state a valid cause of action in equity.

C. The Circuit Court of Appeals for the Eighth Circuit erred in holding that Federal Equity Rule 25 did not obviate the necessity, in patent infringement equity suits, of negativing the provisions of Sections 4886 and 4887 of the United States Revised Statutes, 35 U. S. C. A., Sections 31 and 32.

ARGUMENT.

The Circuit Court of Appeals erred in holding petitioner's Bill of Complaint insufficient to constitute a valid cause of action in equity in view of New Equity Rule 25, the third paragraph of which requires "a short and simple statement of the ultimate facts upon which plaintiff asks relief, omitting any mere statement of evidence."

The ultimate fact upon which, as the rule states "plaintiff asks relief" is the issuance of the patent by the United States Patent Office. As stated by the Circuit Court of Appeals of the Third Circuit in *Moeller vs. Scranton Glass Co.*, 19 F. (2d) 14:

> "Assuredly, such use, sale, or publication was an affirmative fact, to be proved by the defendant and not one the plaintiff was called on to negative. His letters patent issued by the government was the ultimate fact on which, as the rule states, 'the plaintiff asks relief,' and in no sense can this defense matter, which the defendant had to prove, be aptly described as 'an ultimate fact upon which the plaintiff asks relief.'"

Pertinent sections 4886 and 4887 of the United States Revised Statutes are set forth below:

Section 4886 reads as follows:

> "Inventions patentable. Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or who has invented or discovered and asexually produced any distinct and new variety of plant, other than a tuber-propagated plant, now known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discov-

ery thereof, or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor. (As amended May 23, 1930, c. 312, Sec. 1, 46 Stat. 376.)"

Section 4887 reads as follows:

"Sec. 4887. No person otherwise entitled thereto shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid by reason of its having been first patented or caused to be patented by the inventor or his legal representatives or assigns in a foreign country, unless the application for said foreign patent was filed more than twelve months, in cases within the provisions of section forty-eight hundred and eighty-six of the Revised Statutes, and four months in cases of designs, prior to the filing of the application in this country, in which case no patent shall be granted in this country.

"An application for patent for an invention or discovery or for a design filed in this country by any person who has previously regularly filed an application for a patent for the same invention, discovery, or design in a foreign country which, by treaty, convention, or law, affords similar privilege to citizens of the United States shall have the same force and effect as the same application would have if filed in this country on the date on which the application for patent for the same invention, discovery, or design was first filed in such foreign country, provided the application in this country is filed within twelve months in cases within the pro-

visions of section forty-eight hundred and eighty-six of the Revised Statutes, and within four months in cases of designs, from the earliest date on which any such foreign application was filed. But no patent shall be granted on an application for patent for an invention or discovery or a design which had been patented or described in a printed publication in this or any foreign country more than two years before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country for more than two years prior to such filing."

It is obvious that these sections pertain to an inventor's right to obtain a patent and not to the right to sue upon a patent granted. In compliance with these sections of the statute every inventor, along with his application for a patent, must set forth under oath compliance with each and every one of the pertinent provisions thereof. In *Just vs. Borden,* 262 Fed. 163 (Pa.), the court, in approving the short bill, used language relative to these statutes:

"No one has a right to a patent without bringing himself within all the conditions set forth in R. S. in sections 4886-4887. Without the patent he has no property right upon which anyone can trespass. Having that property right, he has a cause of action against anyone who infringes. In other words, his cause of action depends, not upon whether he is within the provisions of the patent laws, but whether, in fact, a patent has been granted to him. It is true the right to claims may be open to question, and the validity of his patent to successful attack; yet, nevertheless, the real condition of things is that without the patent he has nothing, but with it he has all the rights which it grants, until the invalidity of the patent appears."

In *Moeller v. Scranton (supra)* the court said, with reference to these sections of the statute:

> "These are the negative requirements of the Statutes as to the inventive right to a patent; they are not requirements as to a patentee's *prima facie* right of action on the patent granted."

So, to require the plaintiff to set forth compliance with these sections of the statutes in his Bill of Complaint when suing upon his patent, is to require him to deny anticipated defenses. This is and always has been contrary to good pleading. *Chitty on Pleading*, 16th American Edition, page 245, says:

> "It is also a general rule of pleading that matter which should come more properly from the other side need not be stated. In other words, it is enough for each party to make out his own case or defense. He sufficiently substantiates the charge or answer for the purpose of pleading if his pleadings establish a *prima facie* charge or answer. He is not bound to anticipate, and therefore is not compelled to take notice or remove in his declaration or plea, every possible exception, answer or objection which may exist, and with which the adversary may intend to oppose him."

Furthermore, "35 U. S. C. A. Section 69," specifically provides that defendant may plead as a defense non-compliance with any one of these sections of the statutes.

Section 69, title reads as follows:

> In any action for infringement the defendant may plead the general issue, and, having given notice in writing to the plaintiff or his attorney thirty days before, may prove on trial any one or more of the following special matters:

First. That for the purpose of deceiving the public the description and specification filed by the patentee in the Patent Office was made to contain less than the whole truth relative to his invention or discovery, or more than is necessary to produce the desired effect; or,

Second. That he had surreptitiously or unjustly obtained the patent for that which was in fact invented by another, who was using reasonable diligence in adapting and perfecting the same; or,

Third. That it has been patented or described in some printed publication prior to his supposed invention or discovery thereof, or more than two years prior to his application for a patent therefor; or,

Fourth. That he was not the original and first inventor or discoverer or any material and substantial part of the thing patented; or,

Fifth. That it had been in public use or on sale in this country for more than two years before his application for a patent, or had been abandoned to the public.

And in notices as to proof of previous invention, knowledge, or the use of the thing patented, the defendant shall state the names of the patentees and the dates of their patents, and when granted, and the names and residences of the persons alleged to have invented or to have had the prior knowledge of the thing patented, and where and by whom it had been used; and if any one or more of the special matters alleged shall be found for the defendant, judgment shall be rendered for him with costs. And the like defenses may be pleaded in any suit in equity for relief against an alleged infringement; and proofs of the same may be given upon like notice in the answer of the defendant, and

with the like effect. (R. S. 4920; Mar. 3, 1897, c. 391, 2, 29 Stat. 692.)

Therefore the averments pleading compliance with sections 4886 and 4887 of the United States Revised Statutes not only are not ultimate facts, but clearly are excessage or surplus matter, and as such should be stricken from a Bill of Complaint under that part of Rule 25, which requires a "short and simple statement of the ultimate facts."

CONCLUSION.

From the foregoing it appears that the decision of the Circuit Court of Appeals of the Eighth Circuit as rendered is erroneous and has seriously prejudiced the rights of the petitioner.

The petition should be granted.

Respectfully submitted,

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